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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/702,422

11/05/2003

Ernst Engler

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ROHM AND HAAS COMPANY  
PATENT DEPARTMENT  
100 INDEPENDENCE MALL WEST  
PHILADELPHIA, PA 19106-2399

EXAMINER

ROGERS, JAMES WILLIAM

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

07/25/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 10/702,422	Applicant(s) ENGLER ET AL.	
	Examiner James W. Rogers, Ph.D.	Art Unit 1618	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

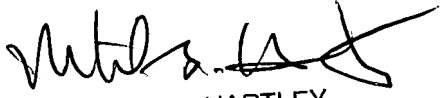
8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants assert that the disclosed range within '274 is so broad that it encompasses a very large number of possible distinct compositions that presents a situation analogous to the obviousness of a species when the prior art broadly discloses a genus as in M.P.E.P. § 2144.05(I). Applicants also assert that '274 does not disclose aqueous compositions. Applicants assert that '274 essentially teaches a genus in which the amounts of isothiazolone and solvent concentrations are hopelessly broadly defined while their invention is a narrow species with a specific combination of concentrations and ingredients. Applicants lastly state that their composition which comprises a stable aqueous dispersion containing a large amount of DCOIT and a low level of solvent is an unexpected result when compared to '274 which only describes in detail an aqueous paint formulation with a low amount of DCOIT.

The relevance of these assertions is unclear. The examiner notes the passage within the M.P.E.P. § 2144.05(I), but the examiner disagrees that this passage applies for this current situation. The '274' reference discloses a broad range of concentrations for the ingredients because the amounts of the ingredients are optimized for the desired end product. Numerous end products are contemplated for use in '274' therefore it would be obvious to one skilled in the art to optimize the concentrations of the ingredients to achieve the desired properties of the end product. Also the examiner disagrees with applicants assessment that the disclosed ranges are so hopelessly broad that they are in fact a genus. Applicants arguments would be persuasive if the upper and lower limits within a reference were enormous in comparison to the claimed upper and lower limits of the claimed invention, for instance if an applicant claims a particle with a diameter of 1 nm-100 nm and a reference disclosed a range of 100 mm-0.1nm, the reference could be considered as teaching a genus of the species because the range is so enormous that it cannot reasonably anticipate or render obvious the very narrow range claimed. However '274 discloses several ingredients within applicants claimed percent range, since the ranges are percents ranging from essentially 0 to 100 the examiner does not consider the ranges described within '274 or the other references to be so broad as to be a genus of applicants claimed invention. Regarding applicants assertion that '274 does not teach aqueous compositions, this statement is untrue, '274 does teach compositions that are aqueous dispersions, the reference does not disclose the amount of water in the aqueous dispersion, which is why it was combined with '565. Regarding applicants assertion of unexpected results, the burden to show unexpected results is high, applicants have only shown that their invention has a low amount of solvent and a high concentration of DCOIT, the percentages of the ingredients as described above and in the previous office action are within applicants claimed range therefore applicants invention is obvious over the cited art. Applicants have only showed that one formulation described within the examples of '274 does not teach their claimed invention but the examples within '274 were given solely for the purpose of illustration and were not to be construed as being limiting to their invention since many variations are possible without departing from the spirit and scope of the invention. In conclusion the examiner stands by his final rejection in the office action dated 05/11/2007 because the references disclosed in that office action describe in combination the same compositions with the same ingredients within applicants claimed range. It is a prima facie case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art. E.g., In re Geusler, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (CCPA 1976); In re Malagari, 449 F.2d 1297, 1202, 182 USPQ 549, 553 (CCPA 1974). It is the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages. See In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980) ("[D]iscovery of an optimum value of the result effective variable in a known process is ordinarily within the skill of the art." See, e.g., In re Baird, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In re Paterson Appeal No. 02-1189 (Fed. Cir. January 8, 2003)..

  
MICHAEL G. HARTLEY  
SUPERVISORY PATENT EXAMINER